



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/612,094	07/01/2003	Isaac Weiser	03-11987	5817
------------	------------	--------------	----------	------

25189	7590	02/02/2006
-------	------	------------

CISLO & THOMAS, LLP  
233 WILSHIRE BLVD  
SUITE 900  
SANTA MONICA, CA 90401-1211

EXAMINER

GARCIA, ERNESTO

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/612,094

Applicant(s)

WEISER ET AL.

Examiner

Ernesto Garcia

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006 and.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/20/2006 has been entered.

#### ***Restriction***

Claims 1-3 and 12-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicants timely traversed the restriction (election) requirement in the reply filed on November 1, 2004.

In respect to the additional restriction between the novelty system and the method of constructing the novelty mailed on 1/23/2006, the restriction no longer applies as the method has been amended to a kit for making the novelty assembly as claimed. Accordingly, the amendment received on 1/23/06 affirms that the novelty system has been elected. Further, the system and the kit have been examined.

### ***Claim Objections***

Claims 4-7, 9, and 10 are objected to because of the following informalities:

regarding claim 4, the limitation "said body" in line 14 should be --appendage-- as the another end of the flexible connecting member 21, i.e., the coil spring, is connected to the appendage and not the body (see Fig. 2);

regarding claims 5-7 and 9, --system-- needs to be inserted after "novelty" in line 1;

regarding claim 9, --one or more-- should be inserted before "appendages" in line 2; and,

regarding claim 10, "having" in line 7 should be --comprising-- since it would appear that a flexible connecting member, a coil spring, and connecting structures are required in the claim when the drawings only show a flexible connecting member 21 and a connecting structure 10, and "structure" in line 16 should be --structures--. For purposes of examining the instant invention, the examiner has assumed these

corrections have been made. Further, claim 9 depends from cancelled claim 8, the examiner has assumed claim 9 being dependent from claim 4.

***Claim Rejections - 35 USC § 112***

Claims 6, 7, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, the limitation “configured to connect to said one or more appendages” in lines 2-3 makes unclear what configuration of the connecting structure is required to allow the connecting structure to connect to the one or more appendages.

Regarding claim 7, the limitation “configured to secure to said second end of said connecting structure” in lines 2-3 makes unclear what configuration of the enclosure is required to allow the enclosure to secure to the second end of the connecting structure.

Regarding claim 10, the limitation “configured for connection of said appendages to said body” in line 8 makes unclear what configuration of the connecting structures is required to allow the connecting structures for connection of the appendages to the body. Further, it is unclear how the recitation “positioning thereby a plurality of prongs

flexible coupled to a first end of each said connecting structures" in lines 15-16 further limits the kit.

Regarding claim 11, it is unclear how the recitation "connecting structures are inserted into said apertures" in lines 2-3 further limits the kit. It appears that once the connecting structures are inserted into the aperture, the components are no longer part of a kit but rather an assembly.

### ***Claim Rejections - 35 USC § 102***

Claims 4 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Higdon, 5,375,363.

Regarding claim 4, Higdon discloses, in Figures 5, 6, and 10, a body **12**, an appendage **16**, and a connecting structure **354**. The body **12** has apertures **366** (Fig. 10), **A1** (see marked-up attachment; Figure 6). The appendage **16** corresponds to one of the apertures **366**. The appendage **16** includes at least one flexible connecting member **30**. The connecting member **30** comprises a coil spring. The connecting structure **354** comprises a post **A2** (see marked-up attachment; Figure 5) with prongs **364** (Fig. 10) flexibly coupled to the first end of the post. The prongs **364** extend toward the body **12**. One end of the flexible connecting member **30** is connected to the

connecting structure **354** and another end of the connecting member **30** is connected to the appendage **16**.

Regarding claim 9, the connecting member **30** has a spring constant that allows the appendage **16** to be freely movable with respect to the body responsive to wind.

***Claim Rejections - 35 USC § 103***

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higdon, 5,375,363, as applied to claim 4, and further in view of Weiser et al., 6,599,160.

Regarding claim 5, Higdon, as discussed, fails to disclose the one appendage comprising a wing structure. Weiser et al. teach an appendage comprising a wing structure to make a decoy as close to impart life-like movement to a bird. Therefore, as taught by Weiser et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the one appendage comprise a wing structure to make the goose of Higdon life-like.

Regarding claim 6, Higdon, as modified, discloses the connecting structure **354** includes a second end **56** to connect to the appendage **16**.

Regarding claim 7, Higdon, as modified, discloses the appendage **16** comprises an enclosure **48** configured to secure to the second end **56** of the connecting structure **354**.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al., 6,599,160, and further in view of Higdon, 5,375,363.

Regarding claim 10, Wiser et al. disclose, in Figure 2, a kit comprising detached novelty portions **4,10,12**. The novelty portions comprise a body **4** and appendages **10,12**. The body **4** has apertures **16**. The appendages **10,12** include at least one flexible connecting member **14** comprising a coil spring extending therefrom. The appendages **10,12** are secured upon assembly. However, the kit fails to include connecting structures. Higdon teaches, in Figure 10, a kit having a connecting structure **354** to connect an appendage **316** to a body **312**. However, Higdon fails to disclose more than one connecting structure. Applicant should not that the courts have held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include more than one connecting structure in the kit of Wiser et al. to connect the appendages to the body instead of extending the coil spring through the body (see Weiser et al.; col. 4, lines 7-16) . *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.



Regarding claim 11, given the modification, the connecting structures will be inserted into the apertures instead of the coil springs extending through the body.

### ***Response to Arguments***

Applicants' arguments with respect to claims 4-7 and 9-11 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30-5:30. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3679

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.

A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is written in a cursive style with a large, looping initial 'D'.

E.G.

January 26, 2006

Attachment: one marked-up page of Higdon, 5,375,363

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

Higdon, 5,375,363

